

## REMARKS

In the Office Action, the Examiner objected to the drawings.

In addition, claim 3 was rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

And, the Examiner rejected claim 3 under § 112, first paragraph, for alleged lack of enablement.

Claim 3 remains pending.

### **A. Objection to Drawings Must Be Withdrawn**

In support of this, the Examiner contended:

The drawings are objected to under 37 CFR1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a *game ball having a cover, a lining and no bladder* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

Page 2 of the Office Action (emphasis in original).

Applicants are confused as to what the Examiner is requesting. In the previous Office Action mailed June 26, 2003, the Examiner objected to the drawings and requested that they illustrate a "game ball having a cover and a bladder." Applicants then remedied that ground of rejection.

Now, the Examiner objected to the drawings and requested that they illustrate a "game ball having a cover, a lining, and no bladder." Even in the event that the Examiner's objection was supportable, this most recent objection should have been raised in the previous Office Action. It is entirely unfair and inequitable for the Examiner to raise this new ground of objection in a final Office Action. Applicants respectfully request that the Examiner reconsider this matter.

Notwithstanding the untimeliness in raising the present objection, it is also without merit for the following reason. Claim 3, the only pending claim, recites a game ball with certain properties, the ball comprising a natural leather cover disposed over a lining. Claim 3 does not recite that the ball does not comprise a bladder. In fact, claim 3 includes game balls that utilize bladders so long as the ball exhibits the characteristics recited in that claim.

The Examiner raised the objection under 37 CFR § 1.83. A careful reading of that section reveals that it states that drawings "must show every [nonconventional] feature of the invention specified in the claims" (bracketed text added). Thus, the Examiner's objection implies that claim 3 is reciting game balls with "no bladder." No, that is not what claim 3 recites.

It is believed that upon further review, the Examiner will agree that the present objection must be withdrawn.

**B. Rejection of Claim 3 for Alleged Lack of Written Description Must Be Withdrawn**

The Examiner rejected claim 3 by asserting:

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time the application was filed, had possession of the claimed invention. *Applicant has failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved during the alleged tanning process for the full range of weight ratios which is critical or essential to the practice of the invention.*

Applicant has mentioned in the specification (page 10) several suitable leathers, which are commercially available, but has failed to disclose what process has been used to produce the "increase water resistant properties" in the natural, leather or that at the time of filing of this application applicant was in possession of this information? Therefore, it is unclear how the unexpected results have been reached, since one skilled in the art will not be able to make or use applicant's invention as originally filed.

Pages 2-3 of the Office Action (emphasis in original).

Applicants revisited this matter and the Examiner's latest allegations. Now, the Examiner asserts that Applicants "failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved."

First, the Examiner is respectfully requested to re-read Applicants' previous Response filed December 29, 2003,<sup>1</sup> and specifically pages 5-9 of that Response. There, the correct standard for evaluating written description under § 112 is set forth as pronounced by the Court of Appeals for the Federal Circuit. And, there, supporting written description in the present application is noted.

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<sup>1</sup> This Response addressed the Office Action mailed June 26, 2003.

Now, in the Examiner's final Office Action, the Examiner is demanding a scientific explanation as to "how" the increased water resistant properties are achieved.

Frankly, the exact scientific mechanism is not, at his time, known. Although Applicants have certain theories in mind, or may speculate, the exact physical process has not been specifically determined.

However, and more importantly for the present rejection, is that the patent laws do not require exact specific explanation of scientific phenomena which may be occurring in the practice of claimed subject matter. In fact, the Court of Appeals for the Federal Circuit has even held that a patentee's misconceptions about the scientific principles underlying a patent are not cause for invalidating that patent:

[A]n otherwise valid patent covering a meritorious invention should not be struck down simply because of the patentee's misconceptions about scientific principles concerning the invention, see *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1570, 219 U.S.P.Q. 1137, 1140 (Fed. Cir. 1983).

*Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1359, 52 U.S.P.Q.2d 1029 (1999). In fact, the Federal Circuit has long held that "[i]t is axiomatic that an inventor need not comprehend the scientific principles on which the practical effectiveness of his invention rests." *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 219 U.S.P.Q. 1137, 1140 (Fed. Cir. 1983).

Again, it is earnestly submitted that the Examiner is applying a significantly higher standard than that which is required under § 112. The Examiner is requested to revisit Applicants' previous Response, and specifically pages 5 to 9 of that Response for an explanation of the correct standard for evaluating the written description requirement of § 112, and why the present application satisfies that requirement. In view of the foregoing, it is believed that the Examiner will agree that this ground of rejection must be withdrawn.

### **C. Rejection of Claim 3 for Alleged Lack of Enablement Must Be Withdrawn**

The Examiner also rejected claim 3 by contending:

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 3, the application as originally filed does not provide support for a game ball without a bladder. The game balls used to

conduct the rain test in Example 1 having a cover, a lining and a bladder, and in Comparative Example 1, the game ball having a Cover and a bladder. No information has been provided to lead one to believe that additional rain tests were conducted for game balls not having a bladder. It is unclear how the claimed ranges were obtained, since there are no tables to support such limitations? Therefore, it is not readily apparent from the claim language that a bladder is present for the claimed game ball.

Page 3 of the Office Action.

This ground of rejection is entirely unsupported and must as a matter of law be withdrawn. The Examiner did not submit any evidence or scientific reasoning to support the view that an artisan could not make the claimed game ball without a bladder. The Examiner is respectfully reminded that the MPEP states in this regard, “[t]he examiner should never make the determination [of enablement] based on personal opinion.” MPEP § 2164.05, emphasis in original, bracketed text added.

Additionally, the Examiner is asked to reconsider pages 9-11 of Applicants' Response filed December 29, 2003<sup>2</sup> in which the correct standard as pronounced by the Federal Circuit for evaluating enablement under § 112 is noted, and the reasons why the current application satisfies such are presented. In view of the foregoing, it is respectfully submitted that this ground of rejection must, as a matter of law, be withdrawn.

#### **D. Examiner's Reply**

The Examiner further argued that:

Applicant's arguments filed 22 March 2004 have been fully considered but they are not persuasive. Applicant's comments regarding the claimed range in claim 3, is not understood, since the claimed range in claim 3 was never an issue. With regards to applicant's assertion that the specification as originally filed provides the requisite written description for the claimed property. As *indicated above*, applicant has failed to sufficiently disclose how the increased water resistant properties for a natural leather cover has been achieved during the alleged tanning process for the full range of weight ratios which is critical or essential to the practice of the invention. Applicant has merely referred to several suitable leathers., which are commercially available, but has failed to disclose what process has been used to produce the "increase water-resistant properties" in the natural leather? Therefore, it is unclear how the unexpected results have been reached, since the tanning imparted on the leather appears to be yielding these unexpected results.

Pages 3-4 of the Office Action.

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<sup>2</sup> This was in response to the Office Action mailed June 26, 2003.

Applicants agree with the Examiner that the ranges recited in claim 3 are not at issue. Reference was made to those ranges to assist in the Examiner's understanding of the specification.

As to the remainder of the Examiner's arguments, Applicants herein present the noted explanations previously presented herein.

#### E. Conclusion

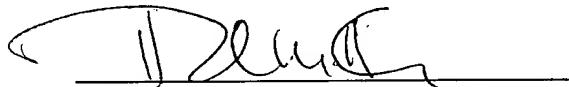
Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 06-0308.

Respectfully submitted,

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#### Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

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Lynda S. Kalemba	